

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

## PCT

To:

see form PCT/ISA/220

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY  
(PCT Rule 43*bis*.1)

Date of mailing  
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference  
see form PCT/ISA/220

**FOR FURTHER ACTION**  
See paragraph 2 below

International application No.  
PCT/US2006/016804

International filing date (day/month/year)  
02.05.2006

Priority date (day/month/year)  
06.05.2005

International Patent Classification (IPC) or both national classification and IPC  
INV. A61K31/397 C07D205/08 A61P1/00

Applicant  
ALLERGAN, INC.

**1. This opinion contains indications relating to the following items:**

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

**2. FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1*bis*(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

**3. For further details, see notes to Form PCT/ISA/220.**

Name and mailing address of the ISA:



European Patent Office  
D-80298 Munich  
Tel. +49 89 2399 - 0 Tx: 523656 epmu d  
Fax: +49 89 2399 - 4465

Date of completion of  
this opinion

see form  
PCT/ISA/210

Authorized Officer

Giacobbe, Simone

Telephone No. +49 89 2399-8463



**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US2006/016804

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**Box No. I Basis of the opinion**

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1. With regard to the **language**, this opinion has been established on the basis of:

- ☒ the international application in the language in which it was filed
- ☐ a translation of the international application into , which is the language of a translation furnished for the purposes of international search (Rules 12.3(a) and 23.1 (b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material:

- ☐ a sequence listing
- ☐ table(s) related to the sequence listing

b. format of material:

- ☐ on paper
- ☐ in electronic form

c. time of filing/furnishing:

- ☐ contained in the international application as filed.
- ☐ filed together with the international application in electronic form.
- ☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

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**Box No. V Reasoned statement under Rule 43*bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

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**1. Statement**

|                               |             |      |
|-------------------------------|-------------|------|
| Novelty (N)                   | Yes: Claims | 1-10 |
|                               | No: Claims  |      |
| Inventive step (IS)           | Yes: Claims | 1-10 |
|                               | No: Claims  |      |
| Industrial applicability (IA) | Yes: Claims | 1-10 |
|                               | No: Claims  |      |

**2. Citations and explanations**

**see separate sheet**

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**Box No. VIII Certain observations on the international application**

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The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

**see separate sheet**

## **1. Section V**

### **1.1 Cited Documents**

The following documents (D) are referred to in this Opinion; the numbering will be adhered to in the rest of the procedure:

D1: US 2003/120079 A1 (ELWORTHY TODD RICHARD ET AL) 26 June 2003  
(2003-06-26)

Unless otherwise indicated reference is hereafter made to the passages cited in the Search Report.

### **1.2 Art 33(2) PCT (Novelty)**

The subject-matter of claims 1-10 of the present application meets the requirements of Article 33(2) PCT.

The cited document does not disclose the medical use of beta-lactams.

### **1.3 Art 33(3) PCT (Inventive step)**

The subject-matter of claims 1-10 of the present application does not meet the requirements of Article 33(3) PCT.

The entire application does not disclose a single example of successful use of one compound falling under the general formula in the treatment of inflammatory bowel disease. Since it is unlikely that every single compound falling under the general formula will be able to do so, the technical problem of finding new compounds for the treatment of inflammatory bowel disease is not solved over the entire scope of the claimed range. Under these conditions no inventive step can be acknowledged.

## **2. Section VIII**

The lack of examples deprives the skilled person trying to reproduce the claimed invention of any guidance, so that he cannot reasonably expect to succeed by simply randomly choosing one possibility within the Markush formula. Lack of disclosure (Art 5 PCT) results.

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| Industrial applicability (IA) | Yes: Claims | 1-10 |
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